

REMARKS

Claims 1-27 are pending, and claims 18-27 withdrawn from consideration, prior to entry of Applicants' instant amendments. Claims 1, 2 and 3 have been amended, claim 11 canceled and new claim 28 added with this action. Applicants respectfully reserve the right to pursue subject matter removed by these amendments in further applications. These amendments add no new matter, and support for these amendments can be found throughout the application as filed. Support for the amendments to claim 1, 2 and 3 can be found, for example, in original claim 12 and at page 9, lines 12-13, and in original claim 3 and at page 10, lines 14-21. Support for new claim 28 can be found, for example, at page 11, lines 15-17.

Applicants gratefully acknowledge the Examiner's withdrawal of prior objections to the specification and rejection under §102(b) for anticipation by Schueler (U.S. Patent No. 2,740,403) in view of Applicants' Response dated February 2, 2006. Applicants aver that the accompanying amendments overcome the remaining rejections, and place the claims in condition for allowance for the reasons that follow.

Rejection under 35 U.S.C. §112(2nd par.)

The Office Action states that claim 3 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, The Office Action states "it is unclear as to what the applicant means by 'said adhesive-carrying porous fabric covers no more than 50% of the **article surface area**'".

The Examiner suggests that Applicant has intended to convey "that the adhesive covers no more than 50% of the surface area of the **fabric surface** on which the adhesive is applied," but this is not what the language in question refers to. Rather, Applicants invention is directed to air and water vapor permeable pressure-sensitive adhesive articles having two layers – a porous backing layer and an adhesive-carrying porous fabric layer. The porousness of each of these layers affects the overall porosity of the article. Applicants have found that, within the structure of their porous articles, it is advantageous to maintain an overall open structure in the adhesive-

carrying fabric layer and that it is therefore disadvantageous to apply an excessive amount and/or an overly viscous pressure-sensitive adhesive formulation to this layer so as to close or “clog” its otherwise open structure. Accordingly, the language “wherein said adhesive-carrying porous fabric covers no more than 50% of the article surface area”, refers to maintaining at least a 50% (or more) open structure (*e.g.* pores) to this second layer after it has been assembled into the two layer article.

While Applicants aver that the language in question is clear on its face, they have amended the claim to recite an adhesive-carrying porous fabric that “is at least about 50% open in structure”. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

Rejection under 35 U.S.C. §103

The Office Action states that claims 1 and 4-17 have been rejected under 35 U.S.C. §103 as being unpatentable over Schueler (U.S. Patent No. 2,740,403) in view of Murphy *et al.* (U.S. Patent No. 5,762,623) “substantially as set forth in 07/28/05 Office action”. The Office Action further states that claims 2 and 3 have been rejected under 35 U.S.C. §103 as being unpatentable over Schueler (U.S. Patent No. 2,740,403) alone. Applicants traverse both of these rejections based upon the Schueler patent for the reasons that follow.

As an initial matter, Applicants respectfully aver that the adhesive bandages taught by the Schueler patent do not provide the level of air permeability as Applicants invention, however, absent an actual sample of the type of bandage devised by Schueler, the Examiner has necessarily been forced to speculate as to its structure and properties. For example, the Office Action states that “the adhesive impregnated lower ply or the carrier 8 of Schneler *et al.* seems to retain its porosity even after the adhesive impregnation” (page 4 of Office Action 4/20/2006), and that “it is the examiner’s position that since Schneler requires the open-mesh fabric to maintain its requisite porosity, the adhesive on the outer surface of the open mesh fabric of Schneler *et al.* would necessarily have to cover no more than 50% of the surface area of the open mesh fabric” (page 11 of Office Action 4/20/2006).

Applicants aver that the specification and drawings of the Schueler patent do not, in fact, support such contentions. In particular, Schuler's "upper ply" shown in Figures 2 and 5 are too closed in structure to maintain sufficient porosity after being laminated to the "lower ply" structure shown in Figure 3. Indeed, the critical relative openness of the structure of the backing is not directly taught by Schueler and the Schueler patent describes the backing as a "closely woven fabric for example having say one hundred yarns to the inch" (at col. 2, lines 42-44, emphasis added). In contrast, Applicants have described an open-structure porous backing that is typically "more than about 50% open area" (page 9, line 13 of the specification). This level of openness of the backing is an important feature of Applicants invention that clearly distinguishes the present invention from the teachings of Schueler. Applicants assert that this feature is implicit in the limitations of the existing claims and teachings of the specification, however, not in acquiescence to the instant rejection but rather in an effort to facilitate prosecution, Applicants have amended independent claims 1, 2 and 3 to specify that the porous backing substrate "is greater than about 25% open area in structure".

Applicants further note the Schueler patent further fails to teach a lower ply layer that is sufficiently open in structure to provide the breathability of Applicants' invention. Indeed Schueler teaches that the lower ply is to be composed of a "similar fabric" to that of the upper ply layer but "more openly woven so that the spaces between the yarns leave openings (that are twice the size of the openings in the upper ply layer)" (col. 2, lines 48-50). Since the upper ply is said to have about 100 yarns/inch of material (col. 2, line 44), the lower ply, being similarly composed, but having twice the size of the openings in the weave, is implicitly described as having about 66 yarns/inch (by simple calculation). In contrast, Applicants specification describes a much more open layer that "can be up to about 95% open...and is typically at least about 50% open" (specification at page 10, lines 18-19), that corresponds, in an exemplary embodiment, to a "warp/weft thread count ranging from about 18 x 12 to about 9 x 12 (yarns/inch)" (specification at page 11, lines 15-17). This much more open lower layer material, in combination with the more open structure of the backing as addressed above, provides the instantly claimed invention with its superior air permeability and "breathable" qualities. Applicants assert that this feature is implicit in the teachings of the specification and limitations

of the existing claims, however, not in acquiescence to the instant rejection but rather in an effort to facilitate prosecution, Applicants have amended independent claims 1 and 2 to specify that the porous backing substrate is “at least about 50% open area in structure”. Claim 3, as amended above, already explicitly recites this feature. Applicants have further added new claim number 28 which specifically covers articles having an adhesive-carrying fabric layer that has a warp/weft thread count ranging from about 18 x12 yarns/inch to about 9 x 12 yarns/inch.

Finally, Applicants, having clearly distinguished the instantly claimed invention from the teachings of the Schueler patent, turn to the Examiner’s assertion that the openness of a fabric or percent open area is considered a mere “result effective variable” (at page 6 of the 4/20/2006 Office Action) and that optimization of a result effective variable is obvious. Applicants respectfully note that, in order to demonstrate a *prima facie* case for obviousness, three basic criteria must be met. (MPEP §2143) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully assert that a *prima facie* case for obviousness in view of the Schueler patent has not been presented because a person of skill in the art would not have been motivated to modify the teachings of Schueler to arrive at the claimed invention, and, still further, because there was no reasonable expectation of success in so doing given the nature of the invention taught by Schueler (bandages) and the prevailing wisdom regarding the properties of the constituent elements of such articles. In particular, the Schueler patent teaches adhesive bandages, and does not teach the broader class of articles that include tapes, as in the instant invention. This distinction is critical because bandages are used to dress wounds. For example, Webster’s Ninth New Collegiate Dictionary defines “bandage” as a strip of fabric used especially to dress and bind up wounds” (emphasis added). Accordingly, one of skill in the art, looking to modify the teachings of Schueler to obtain improved bandages would not have been

motivated to increase the open area of the lower ply layer because this layer is intended to make contact with a wound, and, as such, would need to be sufficiently closed in structure to have the absorbent properties needed for such a function. Furthermore, the person of skill in the art, looking to modify the teachings of Schueler to obtain improved bandages would not have been motivated to increase the open area of the upper ply layer because the Schueler patent itself warns that the upper ply layer should be sufficiently closed to prevent seeping of the adhesive from the lower ply layer upwards to the outer surface of the upper ply layer, and, further, teaches that the outer “breathing pores” would need to be sufficiently small to allow the bandage surface to be washed without allowing so much soap and water under the bandage that adhesive contact with the skin’s surface would be washed away (see col. 1, lines 46-56).

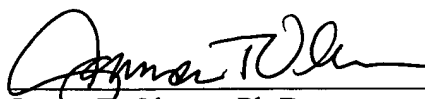
Accordingly, there would have been neither motivation for the person of skill in the art to modify the teachings of Schueler in the manner suggested by the Examiner, nor any reasonable expectation of success in obtaining an improved “bandage” in so doing. Furthermore, the teachings of the remaining art cited (Murphy *et al.* (U.S. 5,762,623) and U.S. 5,914,282) also fail to provide any motivation to modify the teachings of Schueler to arrive at the instantly claimed invention as encompassed by amended claims 1-3. Therefore reconsideration and withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing amendments and accompanying remarks, Applicants respectfully submit that the pending claims have been presented in better form for consideration on appeal per the requirement of 37 C.F.R. §1.116 (b) (2), and, accordingly, the presently presented amendments should be entered and considered. Applicants further respectfully aver that the presently presented claims are in good condition for allowance and prompt notification of such is respectfully requested. If a telephone interview would advance prosecution of the application, the Examiner is invited to call the undersigned at the number listed below.

The time for responding to this action has been extended to August 20, 2006 by the accompanying Petition for a One Month Extension of Time and payment of fee. Applicants believe no other fees are due in connection with this Amendment. However, the Commissioner is authorized to debit Deposit Account No. 08-0219 for any required fee necessary to maintain the pendency of this application or to credit any overpayment to the same Deposit Account.

Respectfully submitted,



James T. Olesen, Ph.D.
Attorney for Applicants
Reg. No. 46, 967

Dated: August 16, 2006

Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109
617-526-6045 (telephone)
617-526-5000 (facsimile)